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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/176,274

10/21/1998

HIDEAKI OHSHIMA

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06/07/2004

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EXAMINER

BRIER, JEFFERY A

ART UNIT

PAPER NUMBER

2672

26

DATE MAILED: 06/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/176,274

Applicant(s)

OHSHIMA ET AL.

Examiner

Jeffery A Brier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 2/26/04 & 4/27/04.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11, 15-25 and 29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 15-25 and 29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The amendment filed on 4/27/2004 has been entered. The amendment overcomes the 35 USC 112 second paragraph rejection. The replacement sheet of drawings for figure 11 has been entered.

Response to Arguments

2. Applicant's arguments filed 02/23/2004 have been fully considered but they are not persuasive.

Claim 1 has been amended to claim:

holding means for holding output images in a first size and output positions thereof, and holding output images in a second size and output positions thereof, wherein each of said output images is expressed by a plurality of objects, and each of said objects is assigned rendering attributes corresponding to a size and output positions.

The specification did not describe wherein each of said output images is expressed by a plurality of objects and each of said objects (of the output image) is assigned rendering attributes corresponding to a size and output positions. At pages 11 and 12 of the 2/23/04 response applicant correlates the holding means, the selection means, the generation means and the rendering means of claim 1 to portions of the specification. Applicant refers to page 13 lines 4-11 as supporting the holding means. A review of page 13 lines 4-11 clearly shows this portion of the specification is describing the window of figure 2 which window does not hold output images that will be: selected by the selection means; used by the generation means; and used by the determination

means. Therefore, applicant has mixed two diverse inventions into one claim without having support in the originally filed specification.

Applicant needs to amend the claims to conform to that which was originally described in the application. Applicant was notified in paper no. 9 in paragraph 6 that claims 6-10 and 20-24 contained allowable subject matter.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-11, 15-25 and 29 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Page 12 lines 6-12 describes the edit processing device 12 as handling image information, character information, frame information from input device 11 as objects. Figure 2 show a window defined by four objects 20, 21, 22 and 23 and by four objects 24, 25, 26 and 27. Figure 4 shows the effects of a window change on objects A, B and C. Figure 6 described at page 21 lines 7-15 shows an object surrounding an image. Figures 10 and 12 shows a photoframe object surrounding an image. Figure 14 shows characters surrounded by a character box object described at page 32 line 21 to page

34 line 12. Page 37 lines 19-25 describes characters and image surrounded by a frame. Page 38 lines 2-11 describe characters as a main object or an image as a main object. Thus, after reviewing the specification as a whole it is clear the specification described handling an image as an object but it did not describe expressing an image by a plurality of objects.

The specification did not describe wherein each of said output images is expressed by a plurality of objects and each of said objects (of the output image) is assigned rendering attributes corresponding to a size and output positions. Applicant is attempting to amend independent claims 1, 15 and 29 with features present at pages 12-26 and claimed in the nonelected group III. Thus, applicant is attempting to take that which was described at pages 12-26 and add it to that which was described at pages 27-42. The specification as filed did not describe doing this. Thus, after reviewing the specification as a whole it is clear the specification described handling an image as an object but it did not describe expressing an image by a plurality of objects.

Cancelled claims 12-14 and 26-28, group III, claimed objects which is described at pages 12-26. Pages 12-26 used objects as the best way to change the size of windows and to determine the placement of objects within the windows.

Originally filed claims 1-11, 15-25 and 29, group II, claimed images which is described at pages 27-42. Pages 27-42 used the term images because photos are being edited, see figures 9, 10, 12 and 14, photos are images.

Applicant is attempting to amend independent claims 1, 15 and 29 with features present at pages 12-26 and claimed in the non elected group III. Thus, applicant is

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attempting to take that which was described at pages 12-26 and add it to that which was described at pages 27-42. The specification as filed did not describe doing this, Thus, one of ordinary skill in the art would not have been conveyed by the originally filed specification and claims that the amended claims that applicant had possession of the currently claimed invention

The dependent claims do not correct the new matter issues found in the independent claims.


5. A prior art rejection cannot be made because the metes and bounds of the claims are not definite and because the specification does not support the claims. Thus, an indication of allowability would be premature.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffery A Brier whose telephone number is 703-305-4723. The examiner can normally be reached on M-F from 6:30 to 3:00. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Razavi, can be reached at (703) 305-4713). The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jeffery A Brier
Primary Examiner
Art Unit 2672